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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,846	03/21/2001	Tadaatsu Nagumo	1614.1141	1451
21171	7590	05/03/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			BARQADLE, YASIN M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/812,846	Applicant(s) NAGUMO, TADAATSU	
	Examiner Yasin M. Barqadle	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/30/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The amendment filed on January 30, 2006 has been fully considered but are not deemed persuasive.

- Claims 1-21 are presented for examination.
- Claim 22 is withdrawn from consideration.

Response to arguments

In response to Applicant's arguments that Powlette does not teach or suggest, "generating a data part from an original print data which is input" as in claim 1. Examiner notes that Powlette teaches generates modified data based on the user's modifying of the initial data, performing annotations via a keyboard/mouse and generating additional data by an applet code in response to a user command from such input device, or some other authorized and accessible data source for the applet (col. 4, lines 32-40 and col. 9, lines 2-14). Powlette further teaches that the modified data file 166 is then displayed in a graphics image format in a separate window 350 where it can be printed to output device 135, fig.1 (col. 11, lines 25-31). Printing original captured image implies generating print data to be printed. Applicant also argues features found in dependent claim 2. Examiner notes that Powlette teaches various kinds of data

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include auxiliary information (col. 3, lines 50-55);

said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and

said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3,7,9 13,16 and 18 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"generating a data part from an original print data which is input" It is not clear what the applicant means

"generating a data part from an original print data" the original specification mentions "[0051] In a step A7, the

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user decides whether or not the document contents subjected to the editing operation are to be printed. If the decision result in the step A7 is YES, the user specifies an existing printer (printer driver) to carry out a print process in a step A8 and the process returns to the step A6." The examiner assumes "generating a data part from an original print data" as the process of printing a document or a file or an image.

Election by Original Presentation

Newly submitted claim 22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they are directed to creating a document data of an original file having predetermined format based on displayed content during a print execute operation and allowing use of the original file across a plurality of apparatuses supporting corresponding formats different from the predetermined format of the original file based on the created document file, classified in class 715, subclass 500. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. **See 37 CFR 1.142(b) and MPEP § 821.03.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Powlette (U.S. Patent No. 6,489,954).

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As per claim 1, Powlette teaches a processing apparatus for generating a file (fig. 1 and abstract), comprising:

a data generating part generating a data part from an original print data which is input (generates modified data based on the user's modifying of the initial data, performing annotations via a keyboard/mouse and generating additional data by an applet code in response to a user command from such input device, or some other authorized and accessible data source for the applet col. 4, lines 32-40 and col. 9, lines 2-14); and

a file generating part generating the file which includes various kinds of data including the data part and a data processing part having the data part as a processing target and developed depending on an execute instruction (the program data is generally associated with modified file data resulting from modifications made by a user to initial data from an initial data file, including files such as chart data files, an audio file, a video file, a text file col. 3, lines 39-56 and col. 4, lines 11-40) (the data file can be printed by user col. 11, lines 25-31)

said file generating part generating the file by including an updating part which updates contents of the file using data modified by the developed data processing part (col. 3, lines 26-31).

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As per claim 2, Powlette teaches the processing apparatus as claimed in claim 1, wherein: said various kinds of data include auxiliary information (col. 3, lines 50-55;

said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and

said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

As per claims 3 and 9,13 and 18, Powlette teaches the invention as shown in (fig. 1 and abstract) comprising:

a developing part developing various kinds of data from a file depending on an execute instruction (fig. 3A-C; col. 5, lines 23-61 and col. 11, lines 4-31), said various kinds of data including a data processing part and a data part which is generated from an original print data and is used by the data processing part (col. 3, lines 39-56; col. 4, lines 11-40 and col. 11, lines 25-31), and an updating part updating contents of the file using data modified by the developed data processing part (col. 3, lines 26-31 and col. 5, lines 23-49).

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As per claims 4,10,14 and 19, Powlette teaches processing apparatus as claimed in claim 3, wherein: said various kinds of data include auxiliary information (fig. 3c; col. 5, lines 23-61 and col. 11, lines 4-31); said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

As per claims 5,11 and 20, Powlette teaches the processing apparatus as claimed in claim 4, wherein said updating part updates the auxiliary information to a present display position of the data part depending on an end instruction (fig. 3c and col. 11, lines 4-31).

As per claims 6,12,15 and 21, Powlette teaches processing apparatus as claimed in claim 3, further comprising: a delete part deleting the developed data processing part and data part at an end of a process (col. 3, lines 50-56).

As per claims 7,16 and 17, Powlette teaches the invention for

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generating a file (fig. 1 and abstract), comprising:

data generating procedure for causing the computer to generate a data part from an original print data which is input (printable file data col. 4, lines 32-40; col. 9, lines 2-14 and col. 11, lines 25-31); and

file generating procedure for causing the computer to generate the file which includes various kinds of data including the data part and a data processing part having as a processing target the data part developed depending on an execute instruction (col. 3, lines 39-56 and col. 4, lines 11-40),

said file generating procedure causing the computer to generate the file by including an updating part which updates contents of the file using data modified by the developed data processing part (col. 3, lines 26-31 and col. 5, lines 23-49).

As per claim 8, Powlette teaches the invention as claimed in claim 7, wherein:

said various kinds of data include auxiliary information (col. 3, lines 50-55;

said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and

said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

Conclusion

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin

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Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

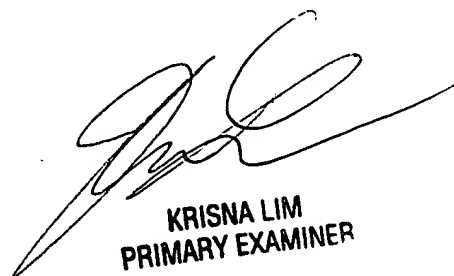
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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KRISNA LIM
PRIMARY EXAMINER